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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,469	08/12/2002	Hans Uwe Faust	1876	3365

7590 12/19/2003
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EXAMINER

NILAND, PATRICK DENNIS

ART UNIT PAPER NUMBER

1714

DATE MAILED: 12/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/069,469	FAUST ET AL. CFO	
	Examiner	Art Unit	
	Patrick D. Niland	1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ | 6) <input type="checkbox"/> Other: _____ |

1. Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. The instant claims recite "obtainable". It is unclear what other products made by other processes are intended to be encompassed by the instant claims due to the use of "obtainable". It would require undue experimentation to determine which other products made by other processes are encompassed by the instant claims due to the use of "obtainable".

The following are supporting descisions for rejecting "obtainable" and similar terms as indefinite.

1. Atlantic Thermoplastics Co. Inc. v Faytex Corp. 23 USPQ 2nd 1481 (1486).

In footnote 6, on page 1486, referring to *Cochrane v Badische Aniline and Soda Fabrik (BASF)*, 11 US 293, the court stated "...because artificial alizarine can take different forms, BASF's claim would be indefinite unless limited to the described process".

The claim referred to is

"Artificial alizarine produced form anthracene or its derivatives by either of the methods described herein or any other method producing a like result."

2. *Ex parte Tanksley* 26 USPQ 2nd 1389

"A claim is indefinite if undue experimetnration is involved to determine boundaries of protection".

This rationale is applicable to polymers obtainable by a stated process because any variation in any parameter within the scope of the claimed process would change the polymer produced. One who made or used a polymer made by a process other than the process recited in the claim would have to produce polymers using all possible parameters within the scope of the claims (temperature, pressure, diluents, component ratios, feed ratios, etc.) and then extensively analyze each product, to determine if his polymer was obtainable by a process within the claimed process.

3. *Purdue Research v Watson* 1959 CD 124 (Dist Ct) affirmed by CCPA 120 USPQ 521.

"Preparable by" was held to not particularly point out and distinctly claim the invention.

"When one has produced a composition of matter where it is not possible to define its characteristics which make it inventive except by reference to the process by which it is produced, one is permitted to so claim the composition produced by the

process referred to in the claims. When the composition is thus claimed in terms of the process of its preparation, the product cannot be defined in such a manner as to assert a monopoly on the product by whatever means produced.

B. Claims 13-14 and 16 provide for the use of the instantly claimed polymer dispersion, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 13-14 and 16 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 6197874 Irle et al..

Irle et al. discloses in situ polymerization of ethylenically unsaturated monomers, including acrylonitrile, in the presence of a polyurethane made with linear polyethers or

polyesters which will necessarily and inherently give the instantly claimed crystallinity to the polyurethane. See the abstract; column 2, lines 20-65; column 3, lines 1-67, particularly 40-50; column 4, lines 1-67, particularly 10 and 35-53; column 5, lines 1-5 and 49-51; column 7, lines 1-5 and 63-67; and the remainder of the document. It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the instantly claimed combinations of ingredients having the instantly claimed physical parameters because they are encompassed by the patentee and would have given only predictable results to the ordinary skilled artisan and the polyacrylate would have to have a T_g in the instantly claimed broad range to be film forming at ambient temperatures.

4. Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 5854332 Swarup et al..

Swarup et al. discloses the instantly claimed polymerization of vinyl monomers, including acrylonitrile, in the presence of a polyurethane made with linear polyethers or polyesters which will necessarily and inherently give the instantly claimed crystallinity to the polyurethane. See the abstract; column 1, lines 5-21; column 2, lines 58-67; column 3, lines 1-67, particularly 21-32; column 4, lines 1-67, particularly 40-43 and 59-67; column 5, lines 1-67, particularly 7-29; column 6, lines 1-67; column 8, lines 1-67, particularly 33-38; column 9, lines 1-67, particularly 21-38 and 44-47; column 12, lines 10-27; and the remainder of the document. It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the instantly claimed combinations of ingredients having the instantly claimed physical parameters because

they are encompassed by the patentee and would have given only predictable results to the ordinary skilled artisan and the polyacrylate would have to have a Tg in the instantly claimed broad range to be film forming at ambient temperatures.

5. Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 6117936 Kato et al..

Kato discloses the instantly claimed polymerization of vinyl monomers, including acrylonitrile, in the presence of a polyurethane made with linear polyethers or polyesters which will necessarily and inherently give the instantly claimed crystallinity to the polyurethane. See the abstract; column 2, lines 20-67; column 3, lines 1-67, particularly 21-32; column 4, lines 1-67, particularly 40-43 and 59-67; column 5, lines 1-67, particularly 7-29; column 6, lines 1-67; column 8, lines 1-67, particularly 33-38; column 9, lines 1-67, particularly 21-38 and 44-47; column 12, lines 10-27; and the remainder of the document. It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the instantly claimed combinations of ingredients having the instantly claimed physical parameters because they are encompassed by the patentee and would have given only predictable results to the ordinary skilled artisan and the polyacrylate would have to have a Tg in the instantly claimed broad range to be film forming at ambient temperatures.


6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick D. Niland whose telephone number is 571-272-1121. The examiner can normally be reached on Monday to Friday from 10am to 5pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Patrick D. Niland
Primary Examiner
Art Unit 1714